

REMARKS

Claims 1-5 are pending in the present patent application (the "Application").

Claims 1-5 have been rejected

Claims 1-5 have been amended.

Claims 6-20 have been added.

Claims 1-20 remain in the Application.

Reconsideration and allowance of the pending claims is respectfully requested.

Title

On Page 2 of the April 23, 2003 Office Action, the Examiner objected to the title as not being descriptive of the invention. The Applicants have amended the title to read "Changing Gear in a Disc Playback Unit With Two Alternate Drive Outputs." The Applicants respectfully submit this new title for approval of the Examiner.

Claim Objections

On Page 2 of the April 23, 2003 Office Action, the Examiner suggested that the phrase "a control element" in Claim 3 should read "a control member" for consistency. The Applicants have amended Claim 3 to make the requested change.

Drawings

On Page 2 of the April 23, 2003 Office Action, the Examiner objected to the drawings under 37 C.F.R. § 1.83(a). The Applicants have amended the claims to remove elements that are not shown in the drawings. The Applicants respectfully submit that the amendment to the claims removes the basis for the Examiner's objections.

Claim Rejections – 35 U.S.C. § 112

On Page 3 of the April 23, 2003 Office Action, the Examiner objected to Claims 1-5 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Applicants have amended Claims 1-5 to provide an antecedent basis for each of the claim elements. The Applicants respectfully submit that the amendment to the claims removes the basis for the Examiner's objection.

Claim Rejections – 35 U.S.C. § 102 (Anticipation)

On Page 4 of the April 23, 2003 Office Action, the Examiner rejected Claim 5 under 35 U.S.C. § 102 as being anticipated by United States Patent No. 5,313,351 to *Lee*. On Page 5 of the April 23, 2003 Office Action, the Examiner rejected Claim 5 under 35 U.S.C. § 102 as being anticipated by United States Patent No. 6,151,279 to *Ikeda et al.* (hereafter "*Ikeda*"). The Applicants respectfully traverse these rejections.

It is axiomatic that a prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131. *See, In re King*, 231 USPQ 126, 138 (Fed. Cir. 1986) (citing with approval, *Lindemann Maschinenfabrik v. American Hoist and Derrick*, 221 USPQ 481, 485 (Fed. Cir. 1984)); *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131. *In re Donohue*, 766 F.2d 531, 534, 226 USPQ 619, 621 (Fed. Cir. 1985).

With respect to Claim 5, a determination of anticipation in accordance with 35 U.S.C. § 102 requires that each feature claimed therein be described in sufficient detail in *Lee* or in *Ikeda* to enable one of ordinary skill in the art to make and practice the claimed invention.

With respect to the *Lee* reference the Examiner stated "Regarding claim 5, Lee teaches a changing gear [fig. 1], in particular for a device for playing and storing several disc shaped data carriers [col.2 lines 29], wherein said changing gear has two alternate drive outputs [8 and 21], the first drive output [8] being designed inter alia for the function of adjusting a control member [16] which can be moved further from an extreme position of the first drive output [8] by means of a further drive [e.g. 21] the result that an adjustment member [16-19] carries out a switching-over operation [open/shut the door] (col.2 lines 53-58)." (April 23, 2003 Office Action, Page 4).

The Applicants respectfully traverse the Examiner's characterization of the subject matter of the *Lee* reference.

The element that the Examiner identified as the first drive output [moving rack 8] does not adjust a control member [identified by the Examiner as connecting gear 16]. Connecting gear 16 of *Lee* is one gear of a plurality of connecting gears in a gear train. Connecting gear 16 is located between connecting gear 15a and connecting gear 19a. Connecting gear 16 is not a control member. Connecting gear 16 is simply a conduit of rotational motion in a gear train of connecting gears. There is no control feature present in connecting gear 16. Further, connecting gear 16 is not "moved further from an extreme position of the first drive input [8] by means of a further drive [e.g. 21]." Opening and shutting rack 21 does not provide drive means for moving a control member. Opening and shutting rack 21 does not move connecting gear 16 "further from an extreme position of the first drive input [8]." *Lee* does not disclose an adjustment member for carrying out a switching over operation between two alternate drive inputs. The Examiner identified the connecting gears 16-19 as "an adjustment member" of the type claimed by the Applicants in Claim 5. The connecting gears 16-19 are not controlled by "a control member" of the type claimed by the Applicants in Claim 5 and are not "an adjustment member" of the type claimed by the Applicants in Claim 5.

For the reasons set forth above, the Applicants respectfully submit that the rejection of Claim 5 as being anticipated by the *Lee* reference has been overcome. The Applicants respectfully request that Claim 5 be passed to allowance.

With respect to the *Ikeda* reference the Examiner stated "Regarding claim 5, *Ikeda* et al teach a changing gear [fig 3], in particular for a device for playing and storing several disc shaped data carriers [311-312], wherein said changing gear has two alternate drive outputs [210] and, the first drive output [8] being designed inter alia for the function of adjusting a control member [16] which can be moved further from an extreme position of the first drive output [8] by means of a further drive [e.g. 21] the result that an adjustment member [16-19] carries out a switching-over operation [open/shut the door] (see fig 3)." (April 23, 2003 Office Action, Page 5). The Applicants respectfully traverse the Examiner's characterization of the subject matter of the *Ikeda* reference.

The element that the Examiner identified as the first drive output [8] does not adjust a control member [16]. The Applicants have found no elements in the *Ikeda* reference that are numbered 8 or 16. The Applicants have found no control member in *Ikeda* that is identical to the control member 14 of the Applicants' invention. The Examiner identified elements [16-19] as an adjustment member. The Applicants have found no elements in the *Ikeda* reference that are numbered 16-19. The Applicants have found no adjustment member in *Ikeda* that is identical to the adjustment member 4 of the Applicants' invention.

For the reasons set forth above, the Applicants respectfully submit that the rejection of Claim 5 as being anticipated by the *Ikeda* reference has been overcome. The Applicants respectfully request that Claim 5 be passed to allowance.

Claim Rejections – 35 U.S.C. § 103 (Obviousness)

On Pages 5-8 of the April 23, 2003 Office Action, the Examiner rejected Claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 6,052,356 to *Fujimoto et al.* (hereafter “*Fujimoto*”) in view of United States Patent No. 5,313,351 to *Lee*. The Applicants respectfully traverse these rejections.

During *ex parte* examinations of patent applications, the Patent and Trademark Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 USPQ 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. MPEP § 2142.

For the reasons set forth below the Applicants respectfully submit that the Patent and Trademark Office has not established a *prima facie* case of obviousness with respect to Claims 1-4 of the Applicants' invention.

The Applicants respectfully submit that the Applicants' invention contains unique and novel claim limitations. For example, consider Claim 1.

1. (Currently amended) A device for playing and storing several disc-shaped data carriers with changing facility, in particular CDs, CD-ROMs, and DVDs, with a playback unit designed for playing a data carrier wherein said device comprises a changing gear which has two alternate drive outputs, the first drive output (2) being designed inter alia for the function of adjusting a control member (14) which is movable further from an extreme position of the first drive output (2) by means of a further drive, with the result that an adjustment member (4) carries out a switching-over operation between the two alternate drive outputs. (Emphasis added).

On Page 6 of the April 23, 2003 Office Action the Examiner stated "Regarding Claim 1, Fujimoto et al teach a device [fig 1] for playing and storing several disc-shaped data carriers [14] with changing facility, in particular CDS, CD-ROMs, and DVDs, with a playback [15] unit designed for playing the data carrier [disks] \* \* \* Fujimoto et al do not teach a changing gear is provided which has two alternate drive outputs, the first drive output being designed inter alia for the function of adjusting a control member which can be moved further from an extreme position of the first drive output by means of a further drive, with a result that an adjustment member carries out a switching-over operation." (April 24, 2003 Office Action, Page 6).

The Applicants agree that the *Fujimoto* reference discloses a device for playing and storing several disc-shaped data carriers with changing facility, in particular CDS, CD-ROMs, and DVDs, with a playback unit designed for playing the data carrier disks.

The Applicants agree that the *Fujimoto* reference does not disclose "a changing gear is provided which has two alternate drive outputs, the first drive output being designed inter alia for the function of adjusting a control member which can be moved further from an extreme position of the first drive output by means of a further drive, with a result that an adjustment member carries out a switching-over operation."

The Examiner has asserted that it would have been obvious to combine the *Lee* reference with the *Fujimoto* reference to overcome the deficiencies of the *Fujimoto* reference. (April 23, 2003 Office Action, Pages 6-7). The Applicants respectfully traverse this assertion of the Examiner.

The Applicants hereby reiterate and incorporate by reference all of the comments that the Applicants have previously made concerning the subject matter of the *Lee* reference. For the reasons that have been previously given, the *Lee* reference does not disclose the unique and novel claim limitations of the Applicants' invention.

The supposed advantage of combining the teachings of the *Lee* reference with the teachings of the *Fujimoto* reference is that would provide "the loading mechanism for loading disks in and out and driving the pick up by a single motor." (April 24, 2003 Office Action, Page 7, Lines 9-10). The Applicants point out that this supposed motivation to combine the references is very general and does not specifically suggest combining the teachings of the *Lee* reference with the teachings of the *Fujimoto* reference. There must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. The supposed motivation is too general and vague to provide the requisite motivation to modify a reference or to combine reference teachings. There is no suggestion or motivation in either *Lee* or *Fujimoto* to combine the two references. The alleged motivation to combine the *Lee* reference and the *Fujimoto* reference originates by considering the Applicants' invention in hindsight.

Even if the *Lee* reference could be combined with the *Fujimoto* reference, the combination would not teach, suggest, or even hint at the Applicants' invention as set forth in Claims 1-4. MPEP § 2142 indicates that a prior art reference (or references when two or more references are

combined) must teach or suggest all the claim limitation of the invention. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not be based on an applicant's disclosure. In the present case, (1) the combination of the *Lee* reference and the *Fujimoto* reference would not teach or suggest all of the unique and novel claim limitations of the Applicants' invention, and (2) the reasonable expectation of success is found in the Applicants' disclosure.

The Applicants respectfully submit that the limitations of independent Claim 1 are not disclosed, suggested or hinted at in the *Lee* reference, or in the *Fujimoto* reference, or in a combination of the two references. Therefore, independent Claim 1 is patentable over the *Lee* reference, and over the *Fujimoto* reference, and over a combination of the two references. The Applicants note that Claims 2-4 depend from Claim 1 and contain all of the unique and novel limitations recited in Claim 1. Therefore, Claims 2-4 are patentable over the *Lee* reference, and over the *Fujimoto* reference, and over a combination of the two references.

The Applicants therefore respectfully requests that the rejection of Claims 1-4 under 35 U.S.C. § 103(a) be withdrawn. The Applicants respectfully request that Claims 1-4 be passed to allowance.

The Applicants further note that newly added Claims 6-20 contain unique and novel limitations that are analogous to the unique and novel limitations recited in independent Claim 1.

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For this reason newly added Claims 6-20 are also patentable over the *Lee* reference, and over the *Fujimoto* reference, and over a combination of the two references.

The Applicants therefore respectfully request that Claims 1-20 be passed to allowance.

The Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. The Applicants reserve the right to submit further arguments in support of his above stated position as well as the right to introduce relevant secondary considerations including long-felt but unresolved needs in the industry, failed attempts by others to invent the invention, and the like, should that become necessary.

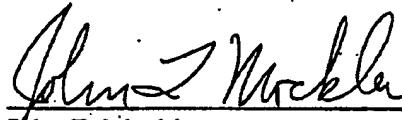
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SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at [jmockler@davismunck.com](mailto:jmockler@davismunck.com). No fees are believed to be necessary; however, in the event that any fees are required for the prosecution of this application, please charge any necessary fees or credit any refunds to Deposit Account No. 50-0208. No extension of time is believed to be necessary. If, however, an extension of time is needed, the extension is requested and please charge the fee for the extension to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.



John T. Mockler  
Registration No. 39,775

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P.O. Drawer 800889  
Dallas, Texas 75380  
(972) 628-3600 (main number)  
(972) 628-3616 (fax)  
E-mail: [jmockler@davismunck.com](mailto:jmockler@davismunck.com)